

REMARKS

This submission is in response to the Official Action dated August 26, 2003. Claims 31 and 33-60 are pending.

In the Office Action, the Examiner has required election of one of the following groups of claims:

I. Claims 31 and 33-48, 58, and 59, drawn to a recombinant plasmid expression vector comprising a first gene and/or a second gene, prokaryotic host cells, and a method for producing polypeptides using said host cells.

II. Claims 49-57, drawn to a method of catalyzing transglycosylation using host cells or the crude or purified extract thereof.

III. Claim 60, drawn to a fusion protein.

In response, Group I, corresponding to claims 31, 33-48, 58 and 59, is hereby elected, with traverse. It is respectfully submitted that groups I and II, *i.e.*, all of claims 31 and 33-59, should be examined in the same application, for the reasons set forth below.

Rejoinder of Groups I and II

Claims 31 and 33-48, 58, and 59 are directed to a recombinant plasmid expression vector comprising two gene sequences encoding polypeptides, one of which having uridine phosphorylase activity and one of which having purine nucleoside phosphorylase activity, and one gene sequence encoding tetracyclin or

kanamycin resistance, as well as host cells comprising such plasmids. Both of the polypeptide-encoding gene sequences originate from a mesophilic bacterium.

Claims 49-57 are directed to a process using host cells comprising such particular expression plasmids, and therefore define a biotechnological process using an also claimed novel composition, *i.e.*, the plasmid expression vector or host cells of claims 31 and 33-48, 58, and 59. Accordingly, claims 49-57 are covered by the special case set forth in 35 U.S.C. §103(b)(3)(c) regarding biotechnology inventions, *i.e.*, that claims to a biotechnological process using an also claimed novel composition should be in one application.

Furthermore, according to the Manual of Patent Examining Procedure, section 821.04,

process claims that depend from or otherwise include all the limitations of the product can be entered as a matter of right if the amendment is presented prior to final rejection or allowance.

It is further noted that the process of using the claimed expression plasmid, designated as Group II by the Examiner, includes all the limitations of the claimed expression plasmid of Group I, designated by the Examiner.

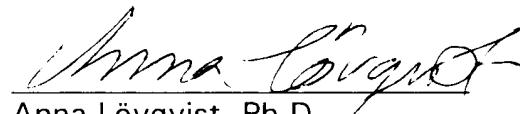
It follows that claims 49-57 fulfill the criteria for rejoinder of both 35 U.S.C. §103(b) and MPEP §821.04, as they are an example of biotechnological process claims using an also-claimed novel product and include the limitations of that also-claimed product. The restriction requirement thereby contradicts the

statues, rules, and case law. See, e.g., 35 U.S.C. §103(b); 37 C.F.R. §1.144; and *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). See also MPEP §§ 706.02(n) and 2116.01. Claims 49-57 are thus properly examined with elected claims 31, 33-48, 58, and 59, and rejoinder is therefore respectfully requested.

* * *

Early and favorable consideration of this response and the claims is earnestly solicited. If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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Limited Recognition Under 37 C.F.R.
10.9(b) (see attached)
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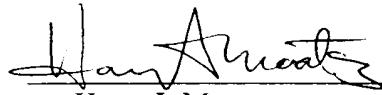
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Expires: February 4, 2004



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